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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,812	05/28/2004	Karen Nadja Pinciro		3811

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W. NORMAN ROTH
523 W. 6TH STREET
SUITE 707
LOS ANGELES, CA 90014

EXAMINER

GRAHAM, MARK S

ART UNIT	PAPER NUMBER
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3711

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/709,812	Applicant(s) PINEIRO ET AL.	
	Examiner Mark S. Graham	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 7-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The indicated allowability of the claims is withdrawn in view of the newly discovered reference(s) to Splaine and a further review of Bureau. Rejections based on the newly cited reference(s) follow.

Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, "said closure" lacks antecedent basis in the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 9, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bureau. Bureau indicates that his device may be made of two mirror image side panels stitched together along their edges. The recited stitching may be considered the flexible band. On the instep portion of this band a zipper is provided as claimed.

Concerning claim 9, note reinforcement panel 60 which may be formed of a heavy-duty fabric. The fabric is not indicated to be stretchable so it is considered non-stretchable.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bureau in view of Kloos et al. (Kloos) and Cirone. Bureau discloses the claimed device with the exception of the stretchable fabric or band. However, as disclosed by Kloos and Cirone it is known to provide such covers for sporting implements in stretchable fabric such that they completely conform to the sports implement. It would have been obvious to one of ordinary skill in the art to have done the same with Bureau's cover as well to allow it to more readily fit the hockey stick blade.

Regarding claims 4 and 5, note Bureau's inner layer 16 and outer layer 60. Bureau's inner layer may be made out of nylon for example which is considered adhesive resistant.

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bureau in view of Thompson.

Bureau discloses the claimed device with the exception of a ventilation means in one of the side panels. Bureau does indicate though that ventilation is a concern which is one reason why he provides notch 28. However, it is also known in the sports implement cover art to provide ventilation holes in the side panels as disclosed by Thompson. It would have been obvious to one of ordinary skill in the art to have done the same with Bureau's device to aid in providing ventilation.

Claims 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bureau in view of Splaine. Bureau discloses the claimed device with the exception of the type of material used for the side panels. However, Bureau makes clear that any suitable material may be used to construct the side panels. Splaine

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discloses a material as claimed which is designed to provide padding. It would have been obvious to one of ordinary skill in the art to have used a material such as Splaine's as Bureau's material to better pad and protect the blade.

Regarding claim 20 Splaine's outer layer is made out of nylon which is considered adhesive resistant.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 17 above, and further in view of Thompson.

Bureau in view of Splaine discloses the claimed device with the exception of a ventilation means in one of the side panels. Bureau does indicate though that ventilation is a concern which is one reason why he provides notch 28. However, it is also known in the sports implement cover art to provide ventilation holes in the side panels as disclosed by Thompson. It would have been obvious to one of ordinary skill in the art to have done the same with Bureau's device to aid in providing ventilation.

Applicant's arguments with respect to claims 3-5, 7-13, and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG
2/13/08

/Mark S. Graham/
Primary Examiner
Art Unit 3711